

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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August 15, 2001

FAXED

FOR DISCUSSION PURPOSES ONLY - NOT TO BE ENTERED

Examiner J. Venkat
GAU 1627
United States Patent and Trademark Office
(703)308-7922

4 page attachment

Re: USSN 09/391,783
Baldwin *et al.*

Examiner Venkat:

Attached is a copy of the Restriction Requirement received in the earlier case (USPN 08/733,803, now USP 6,017,768). Claims 1-2 of the '768 patent were original claims 36 and 37, identified as restriction Group V (page 3). The claims pending in the present divisional case are members of restriction Group II (original claims 4-18). The present application was filed with a preliminary amendment such that only original claims 4-14 were pending. Although this group of claims were all members of a single restriction group in the earlier application (Group II), a further 6-way restriction was received in the present case and Group I (claims 4-7) was elected, along with an election of species. Claims 39-49 were added upon confirmation of the election and are drawn to the elected species.

Please call if you have any further questions. Thank you for your time and consideration

Respectfully,

Date: August 15, 2001

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Office Action Summary

Application No.

08/733,803

Applicant(s)

Baldwin et al

Examiner

P. Achutamurthy

Group Art Unit

1818☒ Responsive to communications; filed on Oct 18, 1996☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire One month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-28 and 35-37 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☐ Claim(s) _____ is/are rejected.☐ Claim(s) _____ is/are objected to.☒ Claims 1-28 and 35-37 are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.☐ received in Application No. (Series Code/Serial Number) _____☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☐ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial Number: 08/733,803
Art Unit: 1218

Page 2

Part III DETAILED ACTION

This is in response to the Preliminary Amendment filed October 18, 1996 which was not made of record in this application until July 19, 1997. This amendment was recieved after the last Office action was mailed. In view of the cancellation of claims 29-34, addition of claims 36, and 37, a new restriction requirement is necessary and is the subject of this Office action.

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-3, 21-28, and 35 drawn to compounds with ligand/linker residue, method of making same, and method of using same for identifying candidate compounds, classified in Class 436, subclass 7.1.

insert application
Group II. Claims 4-18, drawn to pentachlorophenyl group containing compounds, classified in Class 549, subclass 405.

Group III. Claims 19 drawn to a method of inhibiting carbonic anhydrase or its isoenzymes, classified in class 436, subclass 123.

Group IV. Claim 20, drawn to a method of treating glaucoma in a mammal, classified in Class 514 , subclass 913.

Serial Number: 03/733,803

Page 3

Art Unit: 1218

SP
1,017,768
-claim
1-2

* Group V. Claims 36 and 37, drawn to a library of compounds having the recited formula.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are distinct because they are drawn to library of compounds with different structural features.

Inventions II and III or IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product can be used in mutually exclusive materially different methods, such as for treating glaucoma as compared to invention IV or for inhibiting carbonic anhydrase enzyme as compared to invention IV.

Groups I and V are unrelated to each other or to any of the other Groups because they are drawn to compounds not necessarily included in the compounds recited in Groups I or II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and/or because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Serial Number: 06/733,803
Art Unit: 1818

Page 5


Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to P. Achutamurthy whose telephone number is (703) 308-3804. The examiner can normally be reached on Monday-Thursday from 7:00 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams, Ph.D., can be reached on (703) 308-0570. The fax phone number for this Group is (703) 305-7939.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


PONNATHAPURA ACHUTAMURTHY
PRIMARY EXAMINER
GROUP 1800

pa
October 15, 1997